

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Office of Petitions

Applicant:	Michael Reed et al.	:	Confirmation No. 3543
		:	
Serial No.:	08/113,955	:	Art Unit: UNASSIGNED
		:	
Deposited:	August 31, 1993	:	Examiner: UNASSIGNED
		:	
For:	MULTIMEDIA SEARCH SYSTEM	:	

**OPPOSITION TO
“PETITION TO HAVE 3rd PARTY OPPOSITION BE EXPUNGED
AND PETITION UNDER 37 C.F.R. §1.59(b) FOR
EXPUNGEMENT OF THE PRESENT PETITION”**

This is an Opposition to the “PETITION TO HAVE 3rd PARTY OPPOSITION BE EXPUNGED AND PETITION UNDER 37 C.F.R. §1.59(b) FOR EXPUNGEMENT OF THE PRESENT PETITION” filed electronically on February 6, 2008; briefly posted to the PAIR Image File Wrapper for Serial No. 08/113,955; but now either expunged or temporarily removed from the PAIR Image File Wrapper for Serial No. 08/113,955.

Misstatements in the Petition

Commenting first on the misstatements in the Petition to Expunge in the order of occurrence in the Petition to Expunge:

The caption itself is misleading. Serial No. 08/113,955 is not a “Patent Application”, but an “*Incomplete* Patent Application”. It was not “Filed” August 31, 1993, but deposited that date and later determined to be not entitled to a filing date.

The sentence bridging pages 1-2 contains several false statements or implications. The Petition and Amendment filed November 2 and 8, 2007, were not filed in a “patent application”, but in an “*incomplete* patent application”, deemed to be not entitled to a filing date. There are no attorneys or agents of record, only an address for correspondence. The owners of the incomplete patent application are not Encyclopaedia Britannica, but the 14 applicants, as there is no assignment of the incomplete patent application of record. An assignment of a parent patent application is applied to a continuation application, but Serial No. 08/113,955 is neither a continuation (since no timely claim for priority was made) nor an application (since Serial No. 08/113,955 is an *incomplete* patent application, deemed to be not entitled to a filing date).

The remainder of the paragraph bridging pages 1-2 makes false assumptions, concluding that there should be no doubt of the delegation of Mr. Grossman's (alleged) authority to Mr. Hershkovitz. However, it is Mr. Grossman who is primarily without authority. Neither Encyclopaedia Britannica nor the 14 applicants have granted him a power of attorney in Serial No. 08/113,955. A power of attorney in a parent patent application may be applied to a continuation application, but Serial No. 08/113,955 is neither a continuation (since no timely claim for priority was made) nor an application (since Serial No. 08/113,955 is an *incomplete* patent application, deemed to be not entitled to a filing date). And of course, since Mr. Hershkovitz claims authority under Mr. Grossman, Mr. Hershkovitz has no authority, either.

On page 3, paragraph "d", the Petition to Expunge attributes to the Opposition to the Hershkovitz Petition a statement that "Jon Grossman, of Dickstein Shapiro, was the attorney of record". The Opposition to the Hershkovitz Petition said no such thing. Jon Grossman, of Dickstein Shapiro, *asserted* that he was the attorney of record, but neither Encyclopaedia Britannica nor the 14 applicants have granted him a power of attorney in Serial No. 08/113,955.

On page 3, paragraph "e", the Petition to Expunge attributes to the Opposition to the Hershkovitz Petition a statement that 37 C.F.R. § 1.182 "permits a 3rd party to file" the Opposition. The Opposition to the Hershkovitz Petition did not state that 37 C.F.R. § 1.182 explicitly permits a third party to file an Opposition, only that when a petition is an adjunct to litigation proceedings, a reasonable requirement to be imposed is that argument on behalf of other litigants be heard.

The unlettered paragraph in the middle of page 3 asserts that the Opposition was filed by a person without standing, and that it is "prejudicial, misleading, inaccurate, and of no value to the PTO deciding official" These allegations are addressed in turn:

"Without standing": the Opposition was filed by a person with as much standing as Mr. Grossman, Mr. Hershkovitz, or the two of them together.

"Prejudicial": Yes, the Opposition seeks to influence the decision on the Hershkovitz Petition, but not improperly or unduly so.

"Misleading": The Petition to Expunge points to no instance in which the Opposition is misleading. On the contrary, the Hershkovitz Petition is misleading (as is the Petition to Expunge), and the Opposition seeks to prevent the PTO from being misled.

“Inaccurate”: The Petition to Expunge points to no instance in which the Opposition is inaccurate. On the contrary, the HersHKovitz Petition is inaccurate (as is the Petition to Expunge), and the Opposition seeks to prevent the PTO from being misled.

“Of no value”: It is not for Mr. Grossman or Mr. HersHKovitz to say what has value to the PTO deciding official. If, however, the Opposition in fact has no value to the PTO, it can simply be ignored. There is no need to expunge it; and indeed, it is better form for the arguments presented in deciding a matter to be preserved.¹ Patents affected by the 2007 HersHKovitz Petition are in litigation, and the Court may also be interested in what was filed in the PTO.

Response to Allegations

The lettered paragraphs starting in the middle of page 3 explain “Applicant’s” (*i.e.*, Mr. Grossman’s and Mr. HersHKovitz’) position on the Opposition. Opposer’s comments follow:

“a”: Mr. Grossman and Mr. HersHKovitz say that because the prosecution file histories of Serial No. 08/113,955 and its “parent” (presumably reference to U.S. Patent 5,241,671 is intended, although no timely priority claim was ever filed in Serial No. 08/113,955, and it is now too late to do so) are available, the Opposition pointing out relevant facts from the prosecution file histories “has no relevance”. On the contrary, it is believed that pointing out relevant facts from the prosecution file histories will save time of the PTO deciding official; and may prevent relevant facts from being overlooked.

“b”: Mr. Grossman and Mr. HersHKovitz say that the PTO deciding official is capable of rendering an appropriate decision, so there is no need for suggested decisions and rationales for those decisions by a third party having no standing. Indeed, the PTO has made appropriate decisions (Serial No. 08/113,955 is an incomplete application, not entitled to a filing date, no attorney or agent data found, and abandoned before examination), so there is no need for the HersHKovitz Petition or the Petition to Expunge, filed by an attorney or agent not of record.

¹ The disappearance of the Petition to Expunge from the IFW illustrates the problem with the suggestion to expunge our opposition and the petition to expunge (and by extension, the PTO decision on the petition to expunge, since it too would refer to a document no longer existing in the IFW): The document which was once there is just gone, with no explanation.

If the Hershkovitz Petition is considered on the merits, however, the opposing views of litigants should be considered.

“c”: Mr. Grossman and Mr. Hershkovitz say that the litigation-related benefits that would accrue from a decision on the petition are not and should not be relevant to a fair decision. On the contrary, Opposer believes that the expected consequences of a decision are and should be relevant to that decision.

“d” (page 4): Mr. Grossman and Mr. Hershkovitz say that Mr. Grossman was justified in seeking help from Mr. Hershkovitz. Regardless of the facts alleged, neither Encyclopaedia Britannica nor the 14 applicants have granted Mr. Grossman a power of attorney or other explicit authority in Serial No. 08/113,955.

“e” (pages 4-5): Mr. Grossman and Mr. Hershkovitz say that “the regulations are replete with prohibitions of such filings [as the Opposition to the Hershkovitz Petition]”. However, a review of the regulations that Mr. Grossman and Mr. Hershkovitz cite (37 C.F.R. §§ 1.33, 1.34 and 1.291) reveals no such prohibition.²

The Petition to Expunge suggests (page 5) that if the Petition to Expunge is granted, it should itself (and by extension, the decision granting expungement) be expunged, as they would refer to “a non-existing [in the file] document”, which may make the file history of Serial No. 08/113,955 “confusing”. On the contrary, the Petition to Expunge and any decision on it should be preserved in any event, as they may be of interest to a court reviewing the history of the decision that the Hershkovitz Petition urges the PTO to make.

If, however, reference to “a non-existing document” is grounds for expungement, then the Hershkovitz Petition should itself be expunged. The incomplete specification and drawings deposited August 31, 1993, were apparently discarded by the PTO under 37 CFR § 1.53(c) and/or § 1.53(d) in effect at the time, for failure to file a complete specification or for failure to timely pay either a filing fee or an application retention fee. The incomplete specification deposited August 31, 1993, is therefore now “a non-existing document”, to which the Hershkovitz Petition refers, and which the Amendment filed November 8, 2007, seeks to amend.

² 37 C.F.R. § 1.33 has to do with correspondence, which is “generally not ... with more than one patent practitioner *except as deemed necessary*” 37 C.F.R. § 1.34 has to do with acting in a representative capacity. 37 C.F.R. § 1.291 has to do with protests, an example of circumstances in which comments by non-applicants are *considered*, not prohibited.

CONCLUSION

This Opposition should be considered, and not expunged. The Petition to Expunge should be dismissed or denied, and not expunged. The Opposition to the 2007 Hershkovitz Petition should be considered, and not expunged. The 2007 Hershkovitz Petition should be dismissed or denied, and not expunged.

Respectfully submitted,

/Raymond W. Green/
Raymond W. Green
Registration No. 24,587
Opposer

BRINKS HOFER GILSON & LIONE
P. O. Box 10395
Chicago, Illinois 60610
312-321-4200

Dated: February 19, 2008

CERTIFICATE OF SERVICE

I certify that on February 19, 2008, copies of the foregoing Opposition were served by first class mail, postage prepaid, to:

(1) Dickstein Shapiro LLP, 1825 Eye Street NW, Washington DC 20006-5403, correspondence address for Serial No. 08/113,955; and

(2) Abraham Hershkovitz, Hershkovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314, Petitioner.

/Raymond W. Green/
Raymond W. Green
Registration No. 24,587